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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,428	03/31/2004	Paul Buchheit	060963-5007US	8809
83750 7590 11/09/2009 Morgan, Lewis & Bockius LLP/Google 2 Palo Alto Square 3000 El Camino Real, Suite 700 Palo Alto, CA 94306				
EXAMINER				
NGUYEN, DUSTIN				
ART UNIT		PAPER NUMBER		
2454				
NOTIFICATION DATE		DELIVERY MODE		
11/09/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/816,428

**Applicant(s)**

BUCHHEIT ET AL.

**Examiner**

DUSTIN NGUYEN

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 82-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 82-117 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 82-111 are presented for examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 91, 98, 107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 91, 98 and 107, the phrase "substantially" renders the claim(s) indefinite because the claim(s) include(s) relative terminology thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(b and d).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 82, 84-88, 91-95, 98-100, 102-104, 107-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ].

5. As per claim 82, Moody discloses the invention as claimed including a method for searching messages in a conversation-based message system [ i.e. system and method for searching and retrieving related messages ] [ Figure 5; and Abstract ], comprising:

at a client having one or more processors and memory storing programs executed by the one or more processors, responding to receipt of a query from a requestor, the query having one or more query terms [ i.e. search module provides the user with a query box in which the user may enter one or more search terms ] [ Figure 5; and paragraphs 0009-0012, 0053 and 0054 ], including:

transmitting the query over a network to a conversation management system [ i.e. search module accesses threading service 110 ] [ 108, 100, Figure 1; and paragraphs 0024, 0026, 0053 and 0057 ];

receiving from the conversation management system a list of conversations that match the one or more query terms [ i.e. a list of messages related to the particular message from threading service 110 ] [ paragraphs 0057 and 0064 ], and wherein each conversation comprises one or more messages sharing a common set of characteristics that meet first predefined criteria [ i.e. match user query as well as a set of messages related thereto ] [ paragraphs 0006 and 0057 ] and at least one conversation in the list of conversations comprises a plurality of messages [

i.e. list of related messages may include the matching message and all message in the same thread ] [ paragraph 0057 ]; and

presenting at least a portion of the list of conversations to the requestor [ i.e. display the search results in various ways ] [ paragraphs 0012, 0058-0060 ], each conversation listed in the presented portion of the list being represented as a single item [ paragraphs 0014, 0015, 0059 and 0060 ].

Moody does not specifically disclose each of the conversations in the list having a respective conversation identifier, and the presented portion of the list including a plurality of items, each representing a distinct conversation, at least one of which comprises a plurality of messages, wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation.

Doherty discloses

each of the conversations in the list having a respective conversation identifier [ i.e. identified conversations ] [ Figure 6A; and paragraphs 0034, 0036 and 0077 ], and the presented portion of the list including a plurality of items, each representing a distinct conversation, at least one of which comprises a plurality of messages, wherein each item representing a conversation having a plurality of messages has an associated icon indicating the number of electronic messages in the conversation [ i.e. display post counts or conversation counts ] [ Figure 11; and paragraphs 0073, 0077, 0103 and 0160 ].

It would have been obvious to a person skill in the art at the time the invention was made to incorporate the teaching of Doherty to the system of Moody since it would enable to

quantitatively assess the communication capabilities of individuals of various individuals participating in electronic environment [ Doherty, paragraph 0013 ].

6. As per claim 84, Moody discloses wherein the conversations are presented to the requestor in an order determined in accordance with a date/time value of a most recently received message of each respective conversation in the presented portion of the list [ i.e. display the search results in the order of date ] [ paragraphs 0013, 0058-0060 ].

7. As per claim 85, Moody discloses wherein the conversations are presented to the requestor in an order determined in accordance with, for each respective conversation in the presented portion of the list, a date/time value of a most recently received message that is relevant to the search query [ i.e. display the search results in the order of relevance ] [ paragraphs 0013, 0058-0060 ].

8. As per claim 86, it is rejected for similar reasons as stated above in claim 82. Furthermore, Doherty discloses at a server: receiving a plurality of messages directed to a user [ paragraphs 0066-0070 ], each message having a unique message identifier; generating a plurality of conversations [ Abstract; and paragraphs 0015 and 0077 ], generating a plurality of conversations, each conversation including a respective conversation identifier and unique subset of the plurality of messages [ paragraphs 0034 and 0069 ].

9. As per claim 87, Doherty discloses wherein the respective conversation identifier is

distinct from a subject reference of the message [ 110, Figure 6A ].

10. As per claim 88, Doherty discloses wherein the respective conversation identifier is based in part on information not including a subject reference of the message [ Figure 6A; and paragraphs 0082 and 0085 ].

11. As per claim 91, Moody discloses wherein the two or more electronic messages in a conversation have substantially the same subject reference of the messages and at least one characteristic of the messages other than the subject reference [ i.e. construct item of dynamic interest profile ] [ Figure 6; Abstract; and paragraphs 0061-0065 ].

12. As per claim 92, it is rejected for similar reasons as stated above in claim 85.

13. As per claims 93-95, they are rejected for similar reasons as stated above in claims 86-88.

14. As per claim 98, it is rejected for similar reasons as stated above in claim 91.

15. As per claim 99, it is rejected for similar reasons as stated above in claim 85.

16. As per claim 100, it is rejected for similar reasons as stated above in claim 82.

17. As per claims 102-104, they are rejected for similar reasons as stated above in claims 86-88.
18. As per claim 107, it is rejected for similar reasons as stated above in claim 91.
19. As per claim 108, it is rejected for similar reasons as stated above in claim 85.
20. As per claims 109 and 111, they are rejected for similar reasons as stated above in claim 82.
21. Claims 83, 89, 96, 101, 105, 110, and 112-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ], and further in view of Rohall et al. [ US Patent Application No 2003/0163537 ].
22. As per claim 83, Moody and Doherty do not specifically disclose wherein the single item for a respective conversation in the presented portion of the list of conversation is generated so as to include a text string having a highlighted instance of at least one of the one or more query terms. Rohall discloses wherein the single item for a respective conversation in the presented portion of the list of conversation is generated so as to include a text string having a highlighted instance of at least one of the one or more query terms [ i.e. highlight message ] [ paragraphs



Art Unit: 2454

0066, 0070, 0071, 0075 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Moody, Doherty and Rohall because the teaching of Rohall would enable to provide an effectively reviewing and processing electronic mail and electronic mail threads [ Rohall, paragraph 0005 ]

23. As per claim 89, it is rejected for similar reasons as stated above in claim 83.

24. As per claim 96, it is rejected for similar reasons as stated above in claim 83.

25. As per claim 101, it is rejected for similar reasons as stated above in claim 83.

26. As per claim 105, it is rejected for similar reasons as stated above in claim 83.

27. As per claim 110, it is rejected for similar reasons as stated above in claim 83.

28. As per claims 112-117, they are rejected for similar reasons as stated above in claim 83.

Furthermore, Doherty discloses wherein the single item for a respective conversation in the presented portion of the list includes a subject of the respective conversation [ 110, Figure 6A; and paragraphs 0012, 0064, 0176 ].

29. Claims 90, 97, 106 rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al. [ US Patent Application No 2005/0144157 ], in view of Doherty [ US Patent Application No 2003/0055711 ], and further in view of Douglas E. Comer and Larry L. Peterson, "Conversation-Based Mail" [ hereinafter as Comer ].

30. As per claim 90, Moody and Doherty do not specifically disclose wherein at least one of the conversations comprises a plurality of electronic messages having a close temporal relationship with each other. Comer discloses wherein at least one of the conversations comprises a plurality of electronic messages having a close temporal relationship with each other [ page 8, lines 19-35 ]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Moody, Doherty and Comer because the teaching of Comer would enable to provide tools to organizing the message presented to the user, archiving message for future reference, and reducing the volume of messages [ Comer, page 301, paragraphs 4-7 ].

31. As per claim 97, it is rejected for similar reasons as stated above in claim 90.

32. As per claim 106, it is rejected for similar reasons as stated above in claim 90.

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (571) 272-3971. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached at (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dustin Nguyen/  
Primary Examiner, Art Unit 2454